



10/Reconsideration
Lowman

Response Under 37 C.F.R. § 1.116(a)
EXPEDITED PROCEDURE
Examining Group Art Unit 3625
5-2-03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Dated: April 9, 2003

STEPHEN D. DENTEL,
MICHAEL D. WHITMARSH,
JOHNATHAN R. VOGT
and KIRSTEN B. WISDOM

HP Docket No. 10992740-1

Serial No. : 09/629,254

Group Art Unit 3625

Filed : July 31, 2000

Examiner Jeffrey A. Smith

For : SYSTEM AND METHOD FOR FACILITATING THE
PURCHASE OF COMPATIBLE PRODUCTS

Assistant Commissioner for Patents
Box AF
Washington, D.C. 20231

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GROUP 3600

Sir:

RESPONSE TO OFFICE ACTION

Reconsideration of the Office action dated March 17, 2003 and allowance of all pending claims are respectfully requested in view of the following remarks.

Applicants initially note that claims 1-23, 25 and 29-33 stand rejected under 35 USC 102(e) as being anticipated by Gronemeyer et al. (U.S. Patent No. 6,363,359). Claims 24 and 26-28 stand rejected under 35 USC 103(a) as unpatentable over Gronemeyer et al. (U.S. Patent No. 6,363,359) in view of Benjamin et al. (U.S. Patent No. 6,113,208).

In their previous Response to Office Action (dated February 19, 2003), applicants responded to the aforementioned rejections under 35 U.S.C. 102(e) and 35 U.S.C. 103(a) with a Declaration Under § 1.131. Applicants noted, that Gronemeyer et al. (U.S. Patent No. 6,363,359) indicates a filing date of December 21, 1999, a date less than 8 months prior to the filing date of applicants' pending application. Furthermore, applicants noted that conception of their invention preceded the filing date of Gronemeyer et al., and that they had diligently worked toward reducing their invention to practice from a time prior to the filing date of Gronemeyer et al. Applicants thus asserted that their invention precedes the effective date of Gronemeyer et al. The Declaration Under § 1.131 was signed by all named inventors.

In the present Advisory Action, the Examiner notes that the Declaration Under § 1.131 does not place the application in condition for allowance because it does not "contain an allegation that the acts relied upon to establish the date prior to the reference or activity were carried out in this country or in a NAFTA country or WTO member country." Without conceding that 37 C.F.R. § 1.131 does require such an assertion, applicants hereby submit a new Declaration Under § 1.131 in accordance with the Examiner's direction. The Examiner expressly indicates that "[n]o other deficiencies in the Declaration have been found, and that "[o]therwise, the evidence has been reviewed and it has been determined that such evidence satisfactorily demonstrates a reduction of practice of the invention prior to December 21, 1999—the effective date of the '359 B1 reference."

Accordingly, the attached Declaration Under § 1.131 is submitted for the purpose of establishing invention of the subject matter of the rejected claims prior to the effective date of Gronemeyer et al. This declaration indicates conception in the United States at least as early as August 1999, when applicants began giving presentations regarding the invention to potential partners in developing a commercial implementation of the invention. Documentation demonstrating one such presentation is attached as Exhibit 1 to the Declaration Under § 1.131, such documentation bearing a date of October 11, 1999 (a date prior to the effective date of Gronemeyer et al.).

Following applicants' conception of the invention (and prior to the effective date of Gonemeyer et al.), applicants diligently worked toward reduction to practice of the invention in the United States. Such diligence is demonstrated by the Declaration Under § 1.131, and by the presentation documentation attached thereto as Exhibit 1. A commercial embodiment of the invention was completed by applicants' employer (and an implementation partner, AOL) in early 2000, and was released to the public for use in August 2000, further demonstrating applicants' diligence.


Therefore, in view of the attached Declaration Under § 1.131 (and its Exhibit 1), Gronemeyer et al. should not be considered as prior art, and the Examiner's rejections under both 35 USC 102(e) and 35 USC 103(a) should be withdrawn. The Examiner has acknowledged as much.

The above remarks are believed to address fully the Examiner's rejections, and to place the application in condition for allowance. A prompt indication of the same respectfully is requested. The Examiner is encouraged to telephone the undersigned if any issues remain that may be resolved by a telephonic interview.

Respectfully submitted,

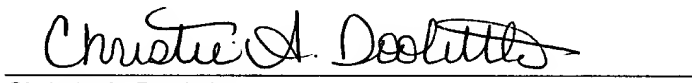
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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on April 9, 2003.


Christie A. Doolittle
Date of Signature: April 9, 2003

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Stephen D. Dentel et al.

Confirmation N.:

Application N.: 09/629,254

Examiner: J. Smith

Filing Date: July 31, 2000

Group Art Unit: 3625

Title: SYSTEM AND METHOD FOR FACILITATING THE
PURCHASE OF COMPATIBLE PRODUCTS

COMMISSIONER FOR PATENTS
Washington, D.C. 20231

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TRANSMITTAL LETTER FOR RESPONSE/AMENDMENT

Sir:

Transmitted herewith is/are the following in the above-identified application:

- (X) Response/Amendment (X) Petition to extend time to respond
() New fee as calculated below () Supplemental Declaration
() No additional fee (Address envelope to "Box Non-Fee Amendments")
(X) Other: Declaration Under § 1.131 (and Exhibit 1) (fee \$)

CLAIMS AS AMENDED BY OTHER THAN A SMALL ENTITY						
(1) FOR	(2) CLAIMS REMAINING AFTER AMENDMENT	(3) NUMBER EXTRA	(4) HIGHEST NUMBER PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEES
TOTAL CLAIMS	33	MINUS	33	= 0	X \$18	\$ 0
INDEP. CLAIMS	3	MINUS	3	= 0	X \$84	\$ 0
[] FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM					+ \$280	\$ 0
EXTENSION FEE	1ST MONTH \$110.00	2ND MONTH \$410.00	3RD MONTH \$930.00	4TH MONTH \$1450.00	\$ 110	
					OTHER FEES	\$
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT						\$ 110

Charge \$ 110 to Deposit Account 08-2025. At any time during the pendency of this application, please charge any fees required or credit any overpayment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231.

Date of Deposit: April 9, 2003

Typed Name: Christie A. Doolittle

Signature: Christie A. Doolittle

Respectfully submitted,

Stephen D. Dentel et al.

By

Walter W. Karnst in

Attorney/Agent for Applicant(s)

Reg. No. 35,565

Date: April 9, 2003